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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.		
09/990,049	11/21/2001	William Ford	282662US8X	1484		
	7590 04/17/200 AK, MCCLELLAND 1	EXAMINER				
1940 DUKE ST	REET	NAFF, DAVID M				
ALEXANDRIA, VA 22314			ART UNIT	PAPER NUMBER		
			1657			
				DELIVERY MODE		
			04/17/2009	ELECTRONIC		

## Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

patentdocket@oblon.com oblonpat@oblon.com jgardner@oblon.com

Office Action Summary		Application N	lo.	Applicant(s)				
		09/990,049		FORD ET AL.				
		Examiner		Art Unit				
		David M. Naff		1657				
The MAILING DATE o Period for Reply	f this communication app	pears on the co	ver sheet with the c	orrespondence ad	ddress			
A SHORTENED STATUTOR WHICHEVER IS LONGER, - Extensions of time may be available to after SIX (6) MONTHS from the mailing - If NO period for reply is specified abor - Failure to reply within the set or exten Any reply received by the Office later earned patent term adjustment. See	FROM THE MAILING D, under the provisions of 37 CFR 1.1 ng date of this communication. we, the maximum statutory period will ded period for reply will, by statute than three months after the mailing	ATE OF THIS 136(a). In no event, h will apply and will exp e, cause the application	COMMUNICATION nowever, may a reply be tin bire SIX (6) MONTHS from to become ABANDONE	N. nely filed the mailing date of this of (35 U.S.C. § 133).	•			
Status								
1)⊠ Responsive to commu	nication(s) filed on 20 /a	anuary 2009						
2a) This action is <b>FINAL</b> .	, ,	s action is non-	final					
/ <del>_</del>	/ <b>—</b>			secution as to the	e merits is			
,	Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under <i>Ex parte Quayle</i> , 1935 C.D. 11, 453 O.G. 213.							
Disposition of Claims	·		,					
·	45 47 and 67 islare nend	ding in the ann	lication					
	Claim(s) <u>25-33,35-43,45,47 and 67</u> is/are pending in the application.							
	4a) Of the above claim(s) is/are withdrawn from consideration.  5) Claim(s) is/are allowed.							
6) Claim(s) is/are								
7) Claim(s) is/are	-							
8) Claim(s) <u>25-33,35-43,</u>	-	et to restriction	and/or alaction roa	uiromont				
0)⊠ Ciaiii(s) <u>20-00,00-40,</u>	43,47 and 07 are subjec	i to restriction	and/or election req	ullelllellt.				
Application Papers								
9)☐ The specification is obj	ected to by the Examine	er.						
10)☐ The drawing(s) filed on	10)☐ The drawing(s) filed on is/are: a)☐ accepted or b)☐ objected to by the Examiner.							
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).								
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).								
11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.								
Priority under 35 U.S.C. § 119								
<ul> <li>12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).</li> <li>a) All b) Some c) None of:</li> <li>1. Certified copies of the priority documents have been received.</li> <li>2. Certified copies of the priority documents have been received in Application No</li> <li>3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).</li> <li>* See the attached detailed Office action for a list of the certified copies not received.</li> </ul>								
Attachment(s)  1) Notice of References Cited (PTO- 2) Notice of Draftsperson's Patent D 3) Information Disclosure Statement Paper No(s)/Mail Date	rawing Review (PTO-948)	4) 5) 6)	Interview Summary Paper No(s)/Mail Da Notice of Informal P Other:	nte				

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## Election/Restrictions

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 1/29/09 has been entered.

An amendment filed 1/29/09 amended claims 31, 40 and 42, and added new claim 67. Claims in the application are 25-33, 35-43, 45, 47 and 67.

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 25-33, 35-39, 43 and 45, drawn to a process of producing a metal particle nucleic acid composite, classified in class 536, subclass 25.4.
- II. Claims 40-42, 47 and 67 drawn to a process for manufacture of a nanowire, classified in class 536, subclass 22.1.

The inventions are independent or distinct, each from the other because:

Inventions I and II are directed to related processes. The related inventions are distinct if:

(1) the inventions as claimed are either not capable of use together or can have a materially different design, mode of operation, function, or effect; (2) the inventions do not overlap in scope, i.e., are mutually exclusive; and (3) the inventions as claimed are not obvious variants.

See MPEP § 806.05(j). In the instant case, the inventions as claimed require different processes such that each process can be performed without the other process. Invention I is making a composite whereas invention II is making a nanowire. Invention I does not have to make a nanowire as required by invention II, and invention II does not have to make a composite as required by invention I. Furthermore, the inventions as claimed do not encompass overlapping subject matter and there is nothing of record to show them to be obvious variants.

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Restriction for examination purposes as indicated is proper because all these inventions listed in this action are independent or distinct for the reasons given above <u>and</u> there would be a serious search and examination burden if restriction were not required because one or more of the following reasons apply:

- (a) the inventions have acquired a separate status in the art in view of their different classification;
- (b) the inventions have acquired a separate status in the art due to their recognized divergent subject matter;
- (c) the inventions require a different field of search (for example, searching different classes/subclasses or electronic resources, or employing different search queries);
- (d) the prior art applicable to one invention would not likely be applicable to another invention;
- (e) the inventions are likely to raise different non-prior art issues under 35 U.S.C. 101 and/or 35 U.S.C. 112, first paragraph.

Applicant is advised that the reply to this requirement to be complete must include

(i) an election of a invention to be examined even though the requirement may be traversed

(37 CFR 1.143) and (ii) identification of the claims encompassing the elected invention.

The election of an invention may be made with or without traverse. To reserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse. Traversal must be presented at the time of election in order to be considered timely. Failure to timely traverse the requirement will result in the loss of right to petition under 37 CFR 1.144. If claims are added after the election, applicant must indicate which of these claims are readable on the elected invention.

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If claims are added after the election, applicant must indicate which of these claims are readable upon the elected invention.

Should applicant traverse on the ground that the inventions are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the inventions to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

## Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David M. Naff whose telephone number is 571-272-0920. The examiner can normally be reached on Monday-Friday 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jon Weber can be reached on 571-272-0925. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent

Application Information Retrieval (PAIR) system. Status information for published applications

may be obtained from either Private PAIR or Public PAIR. Status information for unpublished

applications is available through Private PAIR only. For more information about the PAIR

system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private

PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you

would like assistance from a USPTO Customer Service Representative or access to the

automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/David M. Naff/ Primary Examiner, Art Unit 1657

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DMN 4/11/09